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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,765	04/01/2002	Mauro Costa	costa 5-3-4-4	2874

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Lucent Technologies Inc
Docket Administrator
Room 3C 512
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EXAMINER

APPIAH, CHARLES NANA

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/089,765	COSTA ET AL.	
	Examiner	Art Unit	
	Charles Appiah	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/20/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in the EPO on 20 May, 2000. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 01 April 2002 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al. (6,487,406).

Regarding claim 1, Chang discloses a method of use of mobile telecommunications network (see Fig. 2), comprising utilizing signaling to indicate changes in an IP sub-network (see col. 2, lines 26-66).

5. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Montenegro. (6,571,289).

Regarding claim 1, Montenegro discloses a method of use of mobile telecommunications network (see Figs. 1, 2 and 5), comprising utilizing signaling to indicate changes in an IP sub-network (see col. 3, lines 15-54).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chang et al. (6,487,406)** in view of **Soininen et al. (2002/0049059)**.

Regarding claim 2, Chang discloses a method for a mobile terminal associated with a mobile telecommunications network to register its position and/or update its

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location with regard the mobile telecommunications network and IP registration comprising integrating mobile telecommunications network and IP procedures (see col. 4, lines 46-64, col. 6, line 57 to col. 7, line 55). Chang fails to specifically teach that the mobile telecommunications is UMTS.

Soininen discloses a system that is applicable to any communications requiring macro-mobility management and overlays the mobility management such as IP-type mobility management of an access network such for providing GPRS or third generation (3G) mobile systems such as UMTS (see page 3, sections 0029-section 0032). According to Soininen, using IP-type mobility management enables the detection of the movement of a mobile node and to change and select the most optimal mobility entity in each part of the network without needing non-standard signaling (see page 2, sections 0020-0023).

It would therefore have been obvious to one of ordinary skill in the art to combine the teaching of Soininen by using UMTS procedures to implement Chang's mobile network in order to select the most optimal mobility entity without needing any non-standard signaling or procedure in the network as taught by Soininen.

Regarding claim 3, the combination of Chang and Soininen discloses as taught by Chang using 'register request' and/or 'register complete' messages for detecting IP information (see col. 7, lines 7-55).

Regarding claim 4, Chang further discloses wherein fields of information relevant to the IP domain are with the 'register req' message (see col. 7, lines 7-17).

Regarding claim 5, Chang further discloses wherein the fields are type of home address, type of care of address (COA), and, optionally, any of the following: home IP address, home agents (HA) address and last used COA (see col. 7, lines 7-47).

Regarding claim 6, Chang further discloses wherein additional fields of information are sent with the 'register complete' message (see col. 6, line 65 to col. 7, line 17, and col. 7, lines 47-55).

Regarding claim 7, Chang further discloses wherein the fields comprise home address, COA type and COA (see col. 8, line 55 to col. 9, line 16).

Regarding claims 8 and 9, Chang further discloses using 'locate update' and/or 'location update complete' messages to detect IP information, wherein additional fields of information relevant to the IP domain are sent with the 'location update' message (see col. 5, line 61 to col. 6, line 8 and col. 6, lines 57-65).

Regarding claim 10, Chang further discloses wherein the additional fields comprise home address, COA type and COA (see col. 5, line 65 to col. 6, line 8).

Regarding claims 11 and 12, Chang further discloses wherein additional fields are sent with the 'location update complete' message, wherein the additional fields comprise type and COA (see col. 10, lines 35-48).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jakobsen et al. (6,374,108) discloses a method for assigning an IP address to a mobile station while roaming.

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Li (6,661,780) discloses mechanisms for policy based UMTS QOS and IP QOS management in mobile IP networks.


Purnadi et al. (6,708,031) discloses a method and system for managing internetworking functions for a communication network having both a wireless access network and a packet-switched core network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Appiah whose telephone number is 703 305-4772. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CA


CHARLES APPIAH
PRIMARY EXAMINER